UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,316	01/18/2002	Alfred Thomas	2100/17	8018

7590 02/02/2007

Michael H. Baniak
BANIAK PINE & GANNON
150 N. Wacker Drive, Suite 1200
Chicago, IL 60201

EXAMINER	
OMOTOSHO, EMMANUEL	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/051,316	THOMAS ET AL.	
	Examiner	Art Unit	
	Emmanuel Omotosho	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-47,49-80,82-103,112-114 and 116-127* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-47,49-80,82-103,112-114 and 116-127* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Official Notice

In the office action dated November 1st, 2005 the following Official Notice statements were made and not traversed in the subsequent response by Applicant, accordingly the following statements are considered Applicant Admitted Prior Art.

On page 5 of the afore mentioned office action the Examiner gave Official Notice that it is well known in the art to employ player tracking systems as a means of tracking players and awarding valuable players {those that frequent the gaming establishment and/or spend large sums of money on the gaming machines}. This Feature is now considered to be applicant admitted prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **13**, **23-35**, **56**, and **89**, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims **13, 23, 56,** and **89,** set forth a dependent relationship between the outcome of the first and the outcome of the second game through the following exemplary language.

"...each opening prize indicia being selected as well as discarded in accordance with it's associated card, said card game including the further step of replacing any discarded card with another randomly selected card and said second game of chance including the step of replacing any discarded prize indicia with another randomly selected prize indicia." (Claim 13)

In short claim **13** defines a relationship wherein responsive to a user's interaction with the elements of a first game, the elements of a second game are altered. Accordingly a user's interaction with a first game, such as selecting a game element to discard result in the replacement of the respective element in both a first game and the second game. As the game outcome for both the first and second game are determined by the final composition of the respective game elements, the user's interaction with the first game results altering the outcome of the first game and the second game. This is in direct contradiction to the exemplary independent claim **1** from which claim **13** depends. Exemplary claim **1** as presented defines the game outcomes of the first and second game as being "unrelated" and "irrespective" of one another. It is unclear how game outcomes can be both unrelated and at the same time both contain a result determined by the same user interaction.

As claims **13, 23, 56**, and **89**, set forth an relationship between elements that is contradictory to the relationship between the elements established in their respective independent claims these claims are deemed indefinite for failing to clearly set forth the metes and bounds of the claimed invention in a manner that would be clear to one of ordinary skill in the art of claimed invention.

Claims **24-35** fall for their dependency on independent claim **23** addressed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3-12, 14-21, 36-39, 41, 43-47, 49-55, 57-80, 82-88, 90-103, 114,** and **116-127** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullins (US 5,158,293) in view of Marnell II et al (US 5,332,219) in yet further view of Nelson et al (US 6,749,500).

Claims **1, 11, 41, 47, 64, 78, 96, 98, 103, 114**: Mullins teaches a game including:

A second or Instant game of chance on the same game device that has a second set of positions different from said first set of positions for a second set of game elements different from said first set of game elements (*Mullins* Elm 120, 11 & Fig 3)

and wherein the second game further includes the potential for awarding only a non-monetary prize outcome for every play thereof (*Mullins* Col 3:30-40);

Placing a wager through a wager registering mechanism (*Mullins* Col 2:27-28 & *Marnell* Col 4:43-47);

Operating said second game of chance in conjunction with said first game of chance and in a manner unrelated to any outcome in the first game of chance (*Mullins* Col 2:34-37, 3:30-33, & 4:1-8);

Awarding any prize achieved in said second game of chance irrespective of any outcome in said first game of chance (*Mullins* Col 3:30-33 & Col 4:1-8).

Mullins however is silent regarding the incorporation of a lottery device into a game machine however Marnell teaches the incorporation of a lotto game into a gaming machine as being known in the art of gaming (*Marnell* Col 1:13-25). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the lotto game of Mullins onto an electronic gaming device as taught by Marnell in order to utilize a game delivery platform that would automate lotto sales/redemption and/or to avoid the generation of paper waste and distribution costs associated with the utilization of paper tickets.

The combination of Mullins/Marnell teaches the inclusion of playing cards for simulating card games including poker and blackjack (Mullins Col 3:7-9), however is arguably silent regarding a specific teaching for the inclusion of a card game as the first game of Mullins/Marnell. In a related lottery teaching Nelson teaches the representation of a lottery game as a five card poker game including allowing the player to select which

cards to hold and/or discard (Nelson Col 2:6-12). It would have been obvious to one of ordinary skill in the art at the time of invention to have supplemented the lottery game of Mullins/Marnell with an instant type lottery game representing a five card poker game as taught by Nelson in order to offer the game players and additional lottery game (Mullins Col 2:33-37) as well as a more interesting lottery game (Nelson Col 1:61-64).

Operating a first game of chance including a first set of positions for a first set of game elements and concluding said first game in a monetary outcome/award (*Nelson Col 4:24-32, Col 6:40-48, Col 7:24-43, Col 8:2-5*);

Claims **3-5, 15-19, 37-39, 58-61, 65-71, 73-76, 91-94**: The combination of Mullins/Marnell/Nelson as taught above teaches the awarding of non-monetary prizes (*Mullins* Col 3:38-40 & 4:7-8 & Nelson Col 6:40-48) however is silent regarding the specific inclusion of non-monetary prizes of tangible goods, services, and/or registered point values however, it would have been obvious to one of ordinary skill in the art at the time of invention to have utilized non-monetary prizes including non-monetary prizes of tangible goods, services, and/or registered point values as the non-monetary prizes of Mullins/Marnell/Nelson as one of ordinary skill in the art at the time of invention would have recognized the non-monetary prizes of tangible goods, services, and/or registered point values as equivalents to any other non-monetary prize which the players deem valuable (Mullins Col 3:38-40). Alternatively, it would have been obvious to one of ordinary skill in the art at the time of invention to have utilized non-monetary prizes including non-monetary prizes of tangible goods, services, and/or registered point

values as the non-monetary prizes of Mullins/Marnell/Nelson in order to provide the respective players with the prizes desired by the respective players.

Claims **6, 12, 49, 55, 82, 88**: The combination of Mullins/Marnell/nelson as taught above teaches the operating the second game of chance only once at the beginning of the first game of chance (*Mullins* Col 2:40-50 & Fig 2,3) wherein both games are understood to commence with the distribution of the lottery ticket/game to the player.

Claims **7, 9, 50, 52, 54, 83, 85-87**: The combination of Mullins/Marnell/Nelson as taught above teaches the inclusion of multiple prize indicia (*Mullins* "L","O","T" as shown in Elm 23, and figures 2-3 & Col 2:63-3:9), with a preset number of prize indicia being displayed to the player in the course of the second game (Equated to the 5 prize indicia per row in the instant game of *Mullins* figures 2-3) as randomly selected (*Mullins* Col 5:14-17), and a final prize awarded to the player based on a predetermined association of the prize indicia including matching (*Mullins* Col 2:66-3:9 *'3 bells'*).

Claims **8, 51, 72, 84**: The combination of Mullins/Marnell/Nelson as taught above teaches a plurality of different prize awards (*Mullins Elm 121 line numbers 1,4,8 with respective payouts of $10, $1, and $100*).

Claim **10, 53**: The combination of Mullins/Marnell/Nelson teaches the inclusion of the same number of game elements of five in a first lottery based card game (Nelson Col 4:33-39) and in a second game (Mullins Elm 121). Wherein the cards are dealt/presented to the player in the first game (Nelson Col 2:6-15).

Claim **14, 36, 57, 90, 99 116-127**: The combination of Mullins/Marnell/Nelson teaches the use of a video display for displaying the outcome of a poker game as taught below in at least the rejection of claim 79, however Mullins/Marnell/Nelson is silent regarding the particular use mechanical or video reels for displaying the result of a poker game. The examiner gives Official Notice that the utilization of a plurality of mechanical and video reels display directly related to the number of game elements being displayed is exceptionally old and well known in the art of gaming for displaying the results of card games including poker. It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized mechanical or video slot reels as the poker game result display in the game of Mullins/Marnell/Nelson in order to utilize a display technology best suited to the target player age group or alternative utilize a display technology better suited to the desired operational environment of the device.

Claim **20, 62, 77, 95, 102:** The combination of Mullins/Marnell/Nelson teaches awarding of a bonus game as a prize to the second game (Mullins Elm 23) wherein upon a bonus qualifying outcome (Mullins Elm 22) in the second game the player receives the ability to participate in a bonus/third game (Mullins Col 4:34-38).

Claims **21, 43, 63**: The combination of Mullins/Marnell/Nelson teach all the limitations of the claims as discussed above, however the presented combinations are silent

regarding the incorporation of a player tracking system and the limiting of game play based thereon. The incorporation of a player tracking system and rewarding of players depending on their interaction is held as Applicant admitted prior art (See note above under 'Applicant Admitted Prior Art'). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include player tracking the combination of Mullins/Marnell/Nelson as an incentive for a player to participate in the player tracking system to receive free game plays.

Claims **44-46**, The combination of Mullins/Marnell/Nelson teach the utilization of tickets vouchers and any form of winnable unit that may be used in a game device (Nelson Col 6:40-48) however is silent regarding the specific inclusion of printers for producing these tickets or vouchers. The Examiner gives Official Notice that it is well known in gaming arts to incorporate printers for printing out tickets or vouchers that a player may redeem at a cashier's station or other place within the gaming establishment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of a printer in the combination of Mullins/Marnell/Nelson to provide an easy, convenient means for players to receive game credits and to lessen the amount of currency handling within a casino.

Claims **79**, **80, 97**: The combination of Mullins/Marnell/Nelson teach the system and method as presented above including a video display (Marnell Col 4:16-18), a CPU (microprocessor) for controlling the game apparatus (Marnell Col 4:53-55), a wager

input mechanism (Marnell Col 4:43-46), a random number generator (Marnell Col 5:44-48), and a stored pay-table imbedded in memory (Marnell Col 5:1-15).

Claim **100**: The combination of Mullins/Marnell/Nelson teaches the system and method as presented above including the use of a wild card (Marnell Col 1:44-56).

Claim **101**: The combination of Mullins/Marnell/Nelson teach the system and method as presented above including the use cards however is silent regarding the specific use of Joker cards. The Examiner gives Official Notice that the use of Joker cards is old and well known in the art of gaming. It would have been obvious to one of ordinary skill in the art at the time of invention to have utilize Joker cards as the wild cards of Mullins/Marnell/Nelson set forth above in the rejection of claim 100, in order to provide a wild card symbol that would not be easily confused with the remainder of the cards in a standard card deck.

Claims **22, 40, 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullins (US 5,158,293) in view of Marnell II et al (US 5,332,219) in further view of Nelson et al (US 6,749,500) in yet further view of Meekins et al (US 6,685,563).

The combination of Mullins/Marnell/Nelson teach the system and method as presented above however is silent regarding the requirement of a wager amount or threshold in order to qualify for a secondary game however, in a related art related

invention Meekins teaches the inclusion of this feature in a lottery device (Col 3:52-67; 5:10-18; 6:14-26).

Allowable Subject Matter

Claims **112-113** are allowed.

Claims **13, 23-35, 56,** and **89** were previously objected to due to dependency on rejected claims. These claims are now subject to rejected under USC 112 as presented above.

Reasons for the indication of allowable subject matter can be found in the previous office action (paper #9, 12/3/03), which is incorporated herein by reference.

Response to Arguments

1. Applicant's arguments (see page 19) filed 9/21/2006 in regards to rejection to claims 13,23-35, 56 and 89 ***35 USC § 112 second paragraph*** have been fully considered but they are not persuasive. Applicant should respectfully note that in conjunction with the above rejection, the first game and the second game as disclosed by the Applicant are still not independent of each other. For the playing of the second game depends on the existence and completion of the first game.

2. Applicant's arguments (see page 20-21) filed 9/21/2006 in regards to Claims **1, 3-12, 14-21, 36-39, 41, 43-47, 49-55, 57-80, 82-88, 90-103, 114,** and **116-127** that stands rejected under 35 U.S.C. 103(a) as being unpatentable over Mullins (US 5,158,293) in view of Marnell II et al (US 5,332,219) in yet further view of Nelson et al (US 6,749,500) have been fully considered but they are not persuasive.

3. Applicant argues, "Unlike the present invention, Mullins' bonus game is played in a manner related to outcomes of the jackpot game and instant-win game: the bonus game is dependent on a jackpot game corresponding to a winning instant game. Applicant's invention is two separate and distinct games of chance with one game played in a manner unrelated to any outcome in the other game". However, in conjunction with the above rejection, Applicant is respectfully further directed to col 2 lines 62- col 3 lines 1-12 and col 3 lines 56-57 where in Mullin disclose that the first instant game could be a Lotto game or a playing card game such as poker or blackjack while the second type game is a known jackpot lottery game. Wherein the outcome of the first game is independent of the second game. The second game would still be played despite the outcome of the first. Mullin disclose a first game type that is different from second game type wherein the play of the second game type is independent of the first game outcome.

4. Applicant argues, "Regardless, the printed sheet containing a predetermined result of Mullins is dramatically different from the gaming machine of Applicants' invention. Besides a first game that concludes to a monetary outcome and a second game that concludes to a non-monetary outcome, Mullins fails to disclose a game having the potential on every play thereof for achieving a prize award that is an aspect of Applicants' invention (Claims 1, 41, 47). It would be illogical for Mullins to have a win on each numbered game line of the instant game, or the same series of numbers on each numbered game line of the jackpot game". However, in conjunction with the above rejection, the Examiner respectfully further points out that Mullin discloses the

game having the potential (or probability) of achieving a prize award on every play of the game (col 3 lines 30-33). Mullin further disclose that substituting a non-monetary award for a monetary award to be old in the gaming art (Col 3 lines 30-40). Applicant argues, "Mullins also fails to disclose a game with a reel display with a plurality of reels (Claim 36). The instant win game, jackpot game and bonus game of Mullins would be cumbersome to play on a reel-type gaming machine. Mullins also fails to disclose operating a game provided a wager is of at least a preset type (Claim 40) and registering an amount bet to award any winnings per a paytable and said wager (Claim 96). The player of Mullins simply purchases the preprinted ticket for scratch-off play. (2:40-50). Applicants' invention generates results using a Random Number Generator (RNG) (Claim 96)." However, as the Examiner as pointed out above, The examiner gives Official Notice that the utilization of a plurality of mechanical and video reels display directly related to the number of game elements being displayed is exceptionally old and well known in the art of gaming for displaying the results of card games including poker. It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized mechanical or video slot reels as the poker game result display in the game of Mullins/Marnell/Nelson in order to utilize a display technology best suited to the target player age group or alternative utilize a display technology better suited to the desired operational environment of the device. The combination of Mullins/Marnell/Nelson teach the system and method as presented above however is silent regarding the requirement of a wager amount or threshold in order to qualify for a secondary game however, in a related art related invention

Meekins teaches the inclusion of this feature in a lottery device (Col 3:52-67; 5:10-18; 6:14-26). The combination of Mullins/Marnell/Nelson teach the system and method as presented above including a video display (Marnell Col 4:16-18), a CPU (microprocessor) for controlling the game apparatus (Marnell Col 4:53-55), a wager input mechanism (Marnell Col 4:43-46), a *random number generator* (Marnell Col 5:44-48), and a stored pay-table imbedded in memory (Marnell Col 5:1-15).

5. Applicant argues "At best, combining Mullins and Marnell suggests playing on an apparatus a jackpot game associated with a corresponding instant win game such that each instant-win game is played in combination with the jackpot game such that any corresponding winning instant game becomes a bonus game. "A reference will teach away if it suggests that the line of development flowing from the reference's disclosures is unlikely to be productive of the result sought by the applicant." Seeln re Gurley, 27 F.3d 551,553 (Fed. Cir. 1994). Contrary to the Examiner, there is no teaching, suggestion or motivation to combine a preprinted lottery ticket of Mullins with an electronic poker game apparatus of Marnell. Although Marnell discloses an electronic gaming device to play gambling games like lotto (1:13- 15), the jackpot game of Mullins teaches away from incorporation on a gaming machine. The jackpot game of Mullins defines a date on which the jackpot drawing will be held. (3:56-60). It is illogical that a player would sit at a gaming machine in the hopes to match a series of numbers displayed on the machine to numbers resultant from a future drawing".

6. However, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it

that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). It should be noted that Mullin is not specifically restricted to Lotto/jackpot games. Mullin disclose the game relating to a lotto games, blackjacks, pokers, etc. lines 62- col 3 lines 1-12. Thus, the reference does not teach away from incorporation on a gaming machine. The combination of Mullins/Marnell teaches the inclusion of playing cards for simulating card games including poker and blackjack (Mullins Col 3:7-9).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Omotosho whose telephone number is (571) 272-3106. The examiner can normally be reached on m-f 8-430.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO

Ronald Laneau
Primary Examiner
1/31/07